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UNITED STATES DISTRICT COURT
DISTRICT OF UTAH, CENTRAL DIVISION

<p>RVS OF AMERICA LLC, a Utah limited liability company,</p> <p>Plaintiff,</p> <p>vs.</p> <p>XPEDITION VEHICLE SERVICE, LLC, a Colorado limited liability company,</p> <p>Defendant.</p>	<p>COMPLAINT FOR DECLARATORY JUDGMENT</p> <p>Case No. 2:23-cv-00898-HCN</p> <p>Judge: Howard C. Nielson, Jr.</p>
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COMES NOW plaintiff RVS OF AMERICA LLC (“RVS” or “Plaintiff”), and brings this Declaratory Judgment action pursuant to 28 U.S.C. § 2201 seeking a declaration that RVS has not infringed and is not infringing a federally-registered trademark:

PARTIES

1. RVS is a Utah limited liability company doing business as ROA OFF-ROAD that uses the website <https://www.rvsofamerica.com/> and has its headquarters at 2995 West 600 North, Lindon, UT 84042.

2. Upon information and belief, defendant XPEDITION VEHICLE SERVICE, LLC (“Defendant”) is a Colorado limited liability company with its place of business in Dacono, Colorado.

JURISDICTION AND VENUE

3. This Court may properly exercise jurisdiction over the parties and the subject matter of this action pursuant to 28 U.S.C. §§ 1331 (Federal Question) and 28 U.S.C. § 1338(a) (any Act of Congress relating to patents and trademarks). In addition, this Court also has subject matter jurisdiction pursuant to 28 U.S.C. § 1332 (diversity), because the amount in controversy exceeds \$75,000 and the Plaintiff is of different citizenship than the Defendant.

4. This Court has personal jurisdiction over the Defendant based on Defendant meeting the threshold for minimum contacts with persons residing in the state of Utah.

5. A true and correct copy of a screenshot of the Defendant's website advertising EarthRoamer-branded vehicles is attached hereto as Exhibit A.

6. In 2016, Defendant teamed up with Matt Andrews and Hillary Federico ("Andrews and Federico"); Defendant displayed a map of Andrews' and Federico's travels while driving an EarthRoamer-branded vehicle; the map shows that Andrews and Federico traveled in an EarthRoamer-branded vehicle throughout Utah, stopping in Park City, Moab, and two other locations in Utah. A picture of an EarthRoamer-branded vehicle driving by what appears to be an iconic Utah location is posted to Defendant's website (*see* Exhibit A). On information and belief, Defendant teamed up with Andrews and Federico to advertise the EarthRoamer brand throughout the state of Utah as Andrews and Federico traveled extensively throughout Utah.

7. A true and correct screen capture from Defendant's website showing Andrews' and Federico's travels through Utah is attached as Exhibit B.

8. Defendant filmed a promotional video in Utah entitled “EarthRoamer – Western Utah Salt Flats”. A true and correct copy of a screenshot of the video posted to the YouTube® platform is attached as Exhibit C.

9. On information and belief, for three months in a row during 2021, representatives of Defendant traveled to Utah to hold events for customers. Defendant held an event for owners of EarthRoamer-branded vehicles in southern Utah called the 2021 Owners’ Rally from September 27 to October 2.

10. On information and belief, Defendant sold a trip experience for owners of EarthRoamer-branded vehicles to gather in Moab, Utah for an event called Moab Adventure from November 9 to November 12.

11. A true and correct copy of a flyer describing the 2021 trip to Utah is attached as Exhibit D.

12. Defendant organized a “sold out” trip to Utah in April 2023 for owners of EarthRoamer-branded vehicles.

13. A true and correct screenshot of a website describing the 2023 trip to Utah is attached as Exhibit E.

14. Defendant operates a website available at <https://earthroamer.com> that is accessible to Utah residents, advertises Defendant’s products and services to

Utah residents, and solicits Utah residents to contact Defendant using the email address sales@earthroamer.com.

15. Defendant purposefully avails itself of the privilege of conducting business in Utah and directly targets residents of Utah through the activities described herein.

16. On information and belief, Defendant's advertising and marketing efforts in Utah have resulted in the sale of at least one EarthRoamer-branded vehicle to a resident of Utah.

17. On or about January 20, 2023, Defendant, through its counsel, sent a demand letter (the "Demand Letter") to Plaintiff alleging that Plaintiff had committed "trademark infringement" of Defendant's EarthRoamer Trademark¹, had engaged in "unfair competition" that "is likely to result in consumer confusion" by a) filing trademark applications for the marks ROAMER 1², ROAMER X³, and ROAMER XL⁴ (collectively, the "ROAMER Marks") and b) performing activities under the ROAMER Marks. The Demand Letter demanded that Plaintiff "cease and desist selling RVs and similar products making use of the

¹ See Exhibit H, U.S. Trademark No. 3,068,323 for EarthRoamer in classes 12, 35, and 41.

² See Exhibit I, U.S. Trademark Application No. 97/414,209 for ROAMER 1 in class 12.

³ See Exhibit J, U.S. Trademark Application No. 97/421,374 for ROAMER X in class 12.

⁴ See Exhibit K, U.S. Trademark Application No. 97/421,394 for ROAMER XL in class 12.

ROAMER names and other names that are confusingly similar to those registered and otherwise used by Xpedition”, and “[detail] the steps RVs of America is taking (and plans to take) to prevent further infringement.”

18. A true and correct copy of the Demand Letter is attached hereto as Exhibit F.

19. On or about February 2, 2023, counsel for the parties held a telephone conference. Plaintiff’s counsel denied that Plaintiff had infringed upon Defendant’s EarthRoamer Trademark, and requested that Defendant allow the ROAMER Marks to co-exist with the EarthRoamer Trademark.

20. On February 24, 2023, counsel for Defendant responded by email, stating that their position “. . . remains as set forth in the letter . . .”, that “. . . the distinction between motorized and non-motorized given the similarities in the products, names, and target consumers is not sufficient . . .”, and that they “. . . reserve all rights.” A true and correct copy of this email thread is attached hereto as Exhibit G.

21. Defendant has threatened to “fully assert its rights”, and, among other things, has asserted that Plaintiff is “plainly infringing” the EarthRoamer Trademark. Exhibit F.

22. Defendant has filed the three opposition proceedings identified below in the Trademark Trial and Appeal Board against the ROAMER Marks.

Proceeding Filing Date	Defendant, Properties	Plaintiff Properties
<u>91288043</u> 11/03/2023	<u>RVS OF AMERICA LLC</u> Mark: ROAMER XL S#: <u>97421394</u>	<u>Xpedition Vehicle Service, LLC d/b/a</u> <u>EarthRoamer</u> Mark: EARTHROAMER S#: <u>78659827</u> R#: <u>3068323</u>
<u>91288044</u> 11/03/2023	<u>RVS OF AMERICA LLC</u> Mark: ROAMER 1 S#: <u>97414209</u>	<u>Xpedition Vehicle Service, LLC d/b/a</u> <u>EarthRoamer</u> Mark: EARTHROAMER S#: <u>78659827</u> R#: <u>3068323</u>
<u>91288049</u> 11/03/2023	<u>RVS OF AMERICA LLC</u> Mark: ROAMER XL S#: <u>97421394</u>	<u>Xpedition Vehicle Service, LLC d/b/a</u> <u>EarthRoamer</u> Mark: EARTHROAMER S#: <u>78659827</u> R#: <u>3068323</u>

23. An actual case or controversy exists between the parties.

24. These accusations and demands threaten injury to Plaintiff and interfere with Plaintiff's ability to do business. Plaintiff brings this action to clarify the rights of the parties and to refute the Defendant's harmful claims.

FACTUAL BACKGROUND

25. RVS through its representative filed the ROAMER Marks, each of which covers class 12 for the following goods:

INT. CL. 12 Recreational vehicles, namely, travel trailers; Camping trailers; Travel Trailers.

26. A true and correct copy of the electronic certificate for the EarthRoamer Trademark is attached hereto as Exhibit H.

27. A true and correct copy of the ROAMER 1 trademark application is attached hereto as Exhibit I.

28. A true and correct copy of the ROAMER X trademark application is attached hereto as Exhibit J.

29. A true and correct copy of the ROAMER XL trademark application is attached hereto as Exhibit K.

30. On November 3, 2023, in the Trademark Trial & Appeal Board, Defendant filed opposition proceeding 91288044 against the ROAMER 1 trademark application. A true and correct copy of this opposition is attached hereto as Exhibit L.

31. On November 3, 2023, in the Trademark Trial & Appeal Board, Defendant filed opposition proceeding 91288043 against the ROAMER XL

trademark application. A true and correct copy of this opposition is attached hereto as Exhibit M.

32. On November 3, 2023, in the Trademark Trial & Appeal Board, Defendant filed a second opposition proceeding 91288049 against the ROAMER XL trademark application. A true and correct copy of this opposition is attached hereto as Exhibit N.

33. It appears that the second opposition proceeding 91288049 against the ROAMER XL trademark application was a mistake; it appears that Defendant intended to file an opposition proceeding against the ROAMER X mark since on October 5, 2023, Defendant had filed an extension request in opposition proceeding 97421374 to oppose the ROAMER X mark. A true and correct copy of this extension request is attached hereto as Exhibit O.

34. A true and correct copy of the website <https://www.rvsofamerica.com/> is attached hereto as Exhibit P.

35. After Examiner Joseph Canfield of the United States Patent & Trademark Office examined the likelihood of confusion between the EarthRoamer Trademark and the Roamer 1 mark on or around December 20, 2022, the United States Patent & Trademark Office issued a Notice of Publication on August 16, 2023, for the Roamer 1 mark. A true and correct copy of the December 20, 2022

Non-final Action for the Roamer 1 mark is attached hereto as Exhibit Q. A true and correct copy of the August 16, 2023 Notice of Publication is attached hereto as Exhibit R.

36. Examiner Joseph Canfield of the United States Patent & Trademark Office examined the likelihood of confusion between the EarthRoamer Trademark and the Roamer X mark in an Office Action dated December 20, 2022.

37. A true and correct copy of the December 20, 2022 Non-final Action for the Roamer X mark is attached hereto as Exhibit S.

38. The United States Patent & Trademark Office issued a Notice of Publication on August 16, 2023, for the Roamer X mark. A true and correct copy of the August 16, 2023 Notice of Publication is attached hereto as Exhibit T.

39. After Examiner Joseph Canfield of the United States Patent & Trademark Office examined the likelihood of confusion between the EarthRoamer Trademark and the Roamer XL mark on or around December 20, 2022, the United States Patent & Trademark Office issued a Notice of Publication on August 16, 2023, for the ROAMER XL mark. A true and correct copy of the December 20, 2022 Non-final Action for the ROAMER XL mark is attached hereto as Exhibit U. A true and correct copy of the August 16, 2023 Notice of Publication is attached hereto as Exhibit V.

FIRST CAUSE OF ACTION

Declaration that Plaintiff Does Not Infringe the EarthRoamer Trademark

40. Each of the previous paragraphs is realleged herein.

41. Plaintiff has not infringed the EarthRoamer Trademark.

42. Plaintiff's intended use of the Roamer Marks, as stated in the filing documents of the Applications, will not infringe the EarthRoamer Trademark.

43. In light of Defendant's threats of litigation and damages pertaining to the EarthRoamer Trademark, Plaintiff has suffered injury and will continue to suffer injury until this Court declares that Plaintiff has not infringed and does not infringe any cognizable trademark right belonging to Defendant.

REQUEST FOR RELIEF

Plaintiff respectfully requests and prays for a declaration of Plaintiff's rights as to the controversies identified between the parties above in this Complaint for Declaratory Judgment, including:

A. A declaration that the RVs and similar products that have been sold by Plaintiff under the ROAMER Marks do not infringe the EarthRoamer Trademark.

B. An order directing the United States Patent and Trademark Office to dismiss with prejudice Proceeding Nos. 91288043, 91288044, and 91288049.

C. That Defendant be ordered to pay all fees, expenses, and costs associated with this action; and

D. That the Court grant such other, further, and additional relief as this Court may deem reasonable and just.

DATED this 12th day of December 2023.

PCFB LLC

/s/ Jared L. Cherry

Gregory D. Phillips

Anderson Fife Marshall & Johnson LC

/s/ Jacob C. Ong